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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/448,606 11/24/99 BONICEL

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EXAMINER

MMC2/0205  
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ART UNIT

PAPER NUMBER

2831

DATE MAILED:

02/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/448,606</b>	Applicant(s) <b>Jean-Pierre Bonicel</b>
	Examiner <b>Chau Nguyen</b>	Group Art Unit <b>2831</b>

Responsive to communication(s) filed on Jan 3, 2001

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-12 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 5, 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, line 2, "at least one layer of wires" is unclear to how this at least one relates to the one or more layers of wires recited in claim 1.

Claim 3, line 2, "at least one wire" is unclear to how this at least one relates to the wires already recited in claim 1.

Claim 3, line 3; Claim 5, line 3; Claim 7, line 3; and Claim 9, line 3 contain the trademark/trade name NUOVINOX. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does

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not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a composite steel wire or tube and, accordingly, the identification/description is indefinite.

Claim 10, line 2, "a plurality of reinforcing wires" is unclear to how these wires relate to the at least one reinforcing wire already recited in claim 1.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazato et al. (4,723832) in view of Kazuya (JP 1-276507).

Okazato et al. discloses a telecommunications cable that is structurally reinforced by incorporating armoring having one layer of wires (2) wherein the layer of wires includes steel wires (claims 1&6). Okazato et al. also discloses a tube (1) that forms a concentric layer of the cable and is obtained from a sheet of steel (claims 4&8)

Okazato et al. does not disclose the steel wires and the steel sheet, each being covered in a layer of stainless (claims 1,2,4,6,8&10). Kazuya discloses a composite steel wire in which a steel core is covered by a layer of stainless steel (4). It would have been obvious to one skilled in the

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art to modify the steel wires and the steel sheet of Okazato et al. by covering each steel wire and the steel sheet with a stainless steel layer as taught by Kazuya to further protect the wires and the sheet since stainless steel is a known highly corrosion-resistant material.

5. Claims 3, 5, 7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazato et al. in view of Kazuya as applied to the claims above, and further in view of Applicant's own disclosure (page 4, lines 7-16).

Re claims 3, 5, 7 and 9, it would have been obvious to one skilled in the art to use the composite steel material sold under the registered trademark NUOVINOX for the wire and the tube of the Okazato et al. cable since this material is commercially available and can be drawn into a wire or a tube. In the case of a wire form, the wire can be used as reinforcing wires or armoring wires as disclosed by the applicant (page 4, lines 7-16).

Re claims 11 and 12, the NUOVINOX composite steel wire comprises the steel core directly contacting the layer of stainless steel.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1 and 6 have been considered but are moot in view of the new ground(s) of rejection.

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***Communication***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is (703) 308-0693.

A handwritten signature in black ink, appearing to read "ChauNnguyen".

Chau N. Nguyen

Patent Examiner

February 1, 2001